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RESPONSE TRANSMITTAL

Applicant : **Goldard, et al. (as amended)**

App. No : 10/063,549

Filed : May 2, 2002

For : POLYPEPTIDES ENCODED BY A
NUCLEIC ACID OVEREXPRESSED
IN ESOPHAGEAL AND KIDNEY
TUMOR (as amended)

Examiner : Patricia Ann Duffy

Art Unit : 1645

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

July 1, 2005

(Date)

AnneMarie Kaiser, Reg. No. 37,649

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

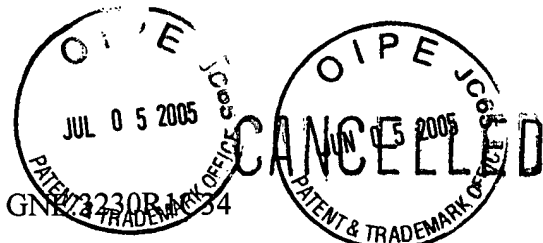
Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Supplemental Response in 3 pages.
- (X) Declaration Under 37 C.F.R. §1.131 with Exhibits A-C.
- (X) Return prepaid postcard.
- (X) Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

AnneMarie Kaiser
Registration No. 37,649
Attorney of Record
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

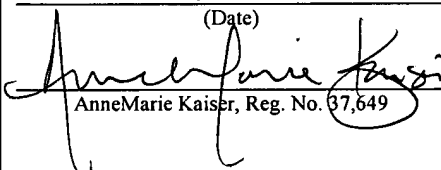
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AnneMarie Kaiser, Reg. No. 37,649

SUPPLEMENTAL RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated March 24, 2005, Applicants filed an amendment and response on June 23, 2005. In that June 23rd Amendment and Response, Applicants fully responded to the issues raised in the Office Action, and submitted the Declaration of Audrey Goddard, Paul J. Godowski, J. Christopher Grimaldi, Austin L. Gurney, and William I. Wood under 37 C.F.R. §1.131.

Applicants hereby submit and request consideration of a replacement Declaration of Audrey Goddard, Paul J. Godowski, J. Christopher Grimaldi, Austin L. Gurney, and William I. Wood under 37 C.F.R. §1.131. The substance of the replacement Declaration remains the same, but the referenced exhibits and signature page of Austin Gurney are included.

Claims 1-13 are rejected under 35. U.S.C. § 102(e) as anticipated by Starling *et al.*, and Khodadoust. As stated in the June 23rd Amendment and Response, the Declaration establishes that the presently claimed invention antedates the priority date the PTO has asserted for Starling *et al.*, December 23, 1999, and Khodadoust, June 25, 1998. The Declaration of Goddard *et al.* establishes that the presently claimed subject matter was conceived prior to the priority dates of

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December 23, 1999 and June 25, 1998, and diligently reduced to practice thereafter. Thus, Applicants respectfully submit that the cited references are not available as prior art.

As set forth in 37 C.F.R. § 1.131, a patent applicant "may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based." *See also*, M.P.E.P. § 715. "The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of the invention in this country ... at least conception being at a date prior to the effective date of the reference." *See* M.P.E.P. § 715.07 (emphasis in original). The showing of facts must be sufficient to show "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice." *See id.*

The Declaration demonstrates that the claimed subject matter, more particularly a polypeptide having the sequence of SEQ ID NO:46 and antibodies to the same, was conceived by Applicants prior to December 23, 1999 and June 25, 1998. Furthermore, as evidenced by the Declaration and accompanying exhibits, Applicants exhibited diligence in reducing the subject matter of the claims to practice by performing various assays to confirm the function of the polypeptide. Therefore, Starling and Khodadoust references are not available as prior art under 35 U.S.C. § 102(e).

In view of the above, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §102(e).

CONCLUSION

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

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Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 1, 2005

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